REMARKS

In the Office Action dated January 22, 2004, the Examiner rejected claims 9-16 under 35 U.S.C. § 112, first paragraph, as lacking support in the specification. The Examiner also rejected claims 1-30 under 35 U.S.C. § 102(e) and/or § 103(a) over Bull et al., U.S. Patent No. 5,995,943, either alone or in combination with one or both of Murray, U.S. Patent No. 6,061,659, and Portuesi, U.S. Patent No. 5,774,666. By this Amendment, Applicants have amended claim 9 to clarify aspects of the invention and claim 17 to correct errors of a typographical or clerical nature. Claims 1-30 remain pending.

Section 112 Rejections

Claims 9-16 were rejected under 35 U.S.C. § 112, first paragraph, as lacking enabling support in the specification. By this Amendment, Applicants have amended claim 9 to clarify aspects of the invention. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the section 112 rejections of claim 9 and claims 10-16, which depend from claim 9.

Section 102(e)/103(a) Rejections

In the Office Action, the Examiner rejected claims 1-2, 4-6, 9-10, 12-13, 21, and 24 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under § 103(a) as obvious over Bull et al. The reference discloses a system in which advertisers may provide criteria that are used to determine when an advertisement/coupon is displayed to a user over a network. (Bull et al., col. 8, ll. 3-4.) Ads/coupons are inserted into an existing web page based on the content of the web page being read by the user using text analysis tools. (Id., col. 5, ll. 19-25, ll. 38-40.) In

addition to the ad/coupon to be displayed, an advertiser can also provide "World Wide Web (WWW) referential information (hot links) to be displayed" to the user. (Id., col. 8, ll. 19-22.)

To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (8th ed. 2001, revised February 2003). Because Bull et al. fails to teach several elements of independent claims 1, 9, 21, 24 and the claims that depend therefrom, Applicants request the reconsideration and withdrawal of the section 102(e) rejections of claims 1-2, 4-6, 9-10, 12-13, 21, and 24.

For example, Bull et al. does not teach an ad server that provides a hypertext anchor to link a word or phrase in a content file to an advertiser web page, as recited in claim 1. Instead, in Bull et al., "ads/coupons are inserted alongside displayed data (text, picture or index display)...." (Bull et al., col. 9, ll. 37-39.) Inserting an ad into an existing web page, as taught by the reference, is not the same as linking a word or phrase to an advertiser's web page, as recited in claim 1. Indeed, the background section of the present application discloses many drawbacks of conventional systems that display advertising alongside content, as is disclosed in Bull et al.

Additionally, the "hot link" of Bull et al. fails to teach an ad server that provides a hypertext anchor to link a word or phrase in a content file to an advertiser web page, as recited in claim 1. Bull et al. teaches that "advertisers can input World Wide Web (WWW) referential information (hot links) to be displayed with ads/coupons...." (Bull et al., col. 8, ll. 19-21.) First, the hot links are clearly not in a content file, as recited in claim 1. Instead, hot links are displayed with ads/coupons, which, as the reference states repeatedly, "are inserted *alongside* displayed data (text, picture or index displays)...." (Id., col. 9, ll. 37-39 (emphasis added); col. 5,

ll. 19-20.) Further, the reference defines a hot link as WWW referential information. This is clearly different from the claimed hypertext anchor to an advertiser-chosen word or phrase.

For at least these reasons, Bull et al. fails to teach every element of claim 1. Furthermore, nothing in the reference suggests this claim element and the Examiner does not allege any suggestion of it. Instead, Bull et al. makes clear that its hot links are not in a content file but are, instead, provided by advertisers, inserted alongside displayed data, and stored in an advertising data store, as discussed above. Therefore, Applicants request the reconsideration and withdrawal of the section 102(e) and section 103(a) rejections of claim 1 and claims 2 and 4-6 that depend therefrom.

Independent claim 21 recites an ad server with means for providing a hypertext anchor to an advertiser-chosen word or phrase in a text-containing file to link to an advertiser file. For at least the reasons given above with regard to claim 1, Bull et al. fails to teach such an apparatus. Furthermore, nothing in the reference suggests this claim element and the Examiner does not allege any suggestion of it. Instead, Bull et al. makes clear that its hot links are not in a content file but are, instead, provided by advertisers, inserted alongside displayed data, and stored in an advertising data store, as discussed above. Because the reference fails to teach or suggest every element of claim 21, Applicants request the reconsideration and withdrawal of the section 102(e) and section 103(a) rejections of claim 21.

Method claims 9 and 24 each recite the step of connecting an ad server to the Internet, wherein the ad server provides a hypertext anchor to an advertiser-chosen word or phrase in a content file (claim 9) or text-containing file (claim 24) to link to an advertiser web page. In the Office Action, the Examiner admitted that Bull et al. does not teach a hypertext anchor, alleging

instead that the hot links of the reference inherently disclose the claimed hypertext anchor. However, inherency requires that "the prior art device, in its normal and usual operation, would necessarily perform the method claimed." (M.P.E.P. § 2112.02, 8th Edition, revised Feb. 2003.) The system of Bull et al. specifically does not perform the claimed method at least because it does not connect an ad server to the Internet, wherein the ad server provides a hypertext anchor to an advertiser-chosen word or phrase in a content or text-containing file, as recited in claims 9 and 24. The Examiner even stated as much, noting that Bull et al. "enables the storage of web pages having hyperlinks to ads," citing the reference's teaching of WWW referential information, i.e., hot links, stored with ads/coupons in an advertising data store. The teaching of storing hot links with ads is exactly the opposite of what is claimed, i.e., providing a hypertext anchor to a word or phrase *in a content or text-containing file.*

Because the reference does not teach, either explicitly or inherently, every element of claims 9 and 24. Furthermore, nothing in the reference suggests this claim element and the Examiner does not allege any suggestion of it. Instead, Bull et al. makes clear that its hot links are not in a content file but are, instead, provided by advertisers, inserted alongside displayed data, and stored in an advertising data store, as discussed above. Therefore, Applicants request the reconsideration and withdrawal of the section 102(e) and section 103(a) rejections of claims 9 and 24, and the claims that depend from either claim 9 or claim 24.

Section 103(a) Rejections

In the Office Action, the Examiner rejected claims 3, 7, 11, 14-15, 22, and 25 under 35 U.S.C. § 103(a) as being obvious over Bull et al. Also under § 103(a), the Examiner rejected claims 8, 16, 23, and 26 as being obvious over Bull et al. in view of Portuesi, claims 17-19 and

27-29 as being obvious over Bull et al. in view of Murray, and claims 20 and 30 as being obvious over Bull et al. in view of Murray further in view of Portuesi.

These rejections are traversed because a *prima facie* case of obviousness has not been made. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03 (8th ed. 2001, Revised February 2003). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Id. at § 2143.01. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. Id. at § 2143.02. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." Id. at § 2143.

Regarding claims 3, 7, 11, 14-15, 22, and 25, a *prima facie* case of obviousness has not been made because Bull et al. fails to teach or suggest every element of the claims. Claims 3 and 7 depend from claim 1, claims 11-15 depend from claim 9, claim 22 depends from claim 21, and claim 25 depends from claim 24. As discussed above, the reference fails to teach every element of independent claims 1, 9, 21, and 24. For example, Bull et al. does not teach an ad server that provides a hypertext anchor to link a word or phrase in a content file to an advertiser web page. Furthermore, nothing in the reference suggests this claim element and the Examiner does not allege any suggestion of it. Instead, Bull et al. makes clear that its hot links are not in a content file but are instead provided by advertisers, inserted alongside displayed data, and stored in an advertising data store, as discussed above.

Additionally, in the Office Action the Examiner alleged, through Official Notice, that it was common, at the time of the invention, to use a script to provide hypertext anchors (as recited in claims 3, 11, 22, and 25) and to display a content provider URL in a browser window using frames (as recited in claims 7, 14, and 15). Applicants note that claims 3, 11, 22, and 25 recite a script to overwrite the existing HTML of a content file with altered HTML including coding to provide a hypertext anchor. Assuming, *arguendo*, that it was common knowledge to use a script to provide hypertext anchors, Applicants respectfully submit that it was not common knowledge to use a script to overwrite the existing HTML of a content file with altered HTML including coding to provide a hypertext anchor, as recited in claims 3, 11, 22, and 25. Applicants therefore object to the taking of Official Notice and request that the Examiner produce documentary support of this allegation or withdraw the Official Notice.

Further, claim 7 recites an altered version of HTML coding that includes coding to display a content provider URL in a browser window of an Internet-enabled web browsing device. Assuming, *arguendo*, that it was common knowledge to display a content provider URL in a browser window using frames, Applicants respectfully submit that it was not common knowledge to use an altered version of HTML coding that includes coding to display a content provider URL in a browser window of an Internet-enabled web browsing device, as recited in claim 7. Applicants therefore object to the taking of Official Notice and request that the Examiner produce documentary support of this allegation or withdraw the Official Notice.

Regarding claims 8, 16, 23, and 26, a *prima facie* case of obviousness has not been made. Claim 8 depends from claim 1, claim 16 depends from claim 9, claim 23 depends from claim 21, and claim 26 depends from claim 24. As discussed above, Bull et al. fails to teach or suggest

every element of independent claims 1, 9, 21, and 24 and their dependent claims. Furthermore, Portuesi does not cure this defect. Portuesi discloses a system that adds a Uniform Resource Locator (URL) track into a movie file in addition to audio and video tracks. (Portuesi, col. 4, l. 63 - col. 5, l. 5.) Nothing in the reference suggests an ad server that provides a hypertext anchor to link a word or phrase in a content file to an advertiser web page.

Additionally, claims 8, 16, 23, and 26 recite linking to an advertiser web page using a tracking URL. This claim element is not taught or suggested by Bull et al. or Portuesi. Regarding this claim element, the Examiner pointed to a teaching in Portuesi of a movie file with a plurality of tracks, including an audio track, an image track, and a URL track. (Portuesi, col. 4, ll. 63-65.) The multiple tracks of a movie file are unrelated to linking to a web page using a tracking URL, as recited in claims 8, 16, 23, and 26.

For these reasons, the references fail to teach or suggest several elements of claims 8, 16, 23, and 26, and Applicants request the reconsideration and withdrawal of the section 103 rejections of these claims.

Claims 20 and 30 also recite linking to an advertiser web page using a tracking URL. As discussed above with reference to claims 8, 16, 23, and 26, this claim element is not taught or suggested by Bull et al. or Portuesi. Furthermore, the Examiner admitted in the Office Action that Murray does not disclose linking to an advertiser web page using a tracking URL. Because the references, taken separately or together, fail to teach or suggest every element of claims 20 and 30, Applicants request the reconsideration and withdrawal of the section 103 rejections of these claims.

Independent claim 17 recites a method including altering the HTML coding of content for an Internet-displayed file to include a hypertext anchor on an advertiser-chosen word or phrase to link to an advertiser web page. Neither Bull et al. nor Murray teaches or suggests such a step. Indeed, the Examiner does not even mention this claim element in the Office Action. As discussed above, Bull et al. fails to teach or suggest a hypertext anchor on an advertiser-chosen word or phrase to link to an advertiser web page. Further, Murray does not cure this defect. Instead, Murray merely discloses a system that uses HTML documents to provide content through a browser using pre-defined HTML tags. (Murray, col. 5, ll. 14-16; col. 6, ll. 32-39.) Nothing in the reference suggests altering the HTML coding to include a hypertext anchor on an advertiser-chosen word or phrase to link to an advertiser web page. Because the cited references, taken separately or together, fail to teach every element of claim 17, Applicants request the withdrawal of the section 103 rejections of claims 17 and its dependent claims 18 and 19.

Independent claim 27 recites a method including altering a document file with software to include a hypertext anchor on an advertiser-chosen word or phrase to link to an advertiser document. Neither Bull et al. nor Murray teaches or suggests such a step. Indeed, the Examiner does not even mention this claim element in the Office Action. As discussed above, Bull et al. fails to teach or suggest a hypertext anchor on an advertiser-chosen word or phrase to link to an advertiser document. Further, Murray does not cure this defect. Instead, Murray merely discloses a system that uses HTML documents to provide content through a browser using pre-defined HTML tags. (Murray, col. 5, ll. 14-16; col. 6, ll. 32-39.) Nothing in the reference suggests altering a document file with software to include a hypertext anchor on an advertiser-chosen word or phrase to link to an advertiser document. Because the cited references, taken

separately or together, fail to teach every element of claim 27, Applicants request the withdrawal of the section 103 rejections of claim 27 and its dependent claims 28 and 29.

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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